

REMARKS

Claims 1-37 are pending in this application. By this Amendment, Claim 16 has been amended to correct a perceived typographical error. Applicants therefore respectfully submit that no new matter has been added to this application nor have any new issues been raised by this amendment. Moreover, it is believed that the claims as presented herein places the application in condition for allowance. Accordingly, entry and consideration of the present Amendment is deemed appropriate as it places the application in condition for allowance.

The Examiner has provisionally rejected Claims 1 and 13-14 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over copending U.S. Application No. 10/699,529. Upon resolution of all outstanding issues remaining in the Office Action, Applicants will consider the timely submission of a Terminal Disclaimer.

The Examiner has finally rejected Claims 1-35 under 35 U.S.C. §103(a) as being unpatentable over Kolosov et al. U.S. Publication No. 2004/0123650 ("Kolosov et al.").

As acknowledged by the Examiner, nowhere does Kolosov et al. disclose or suggest a method for preparing a plurality of different lubricant oil formulations comprising (a) providing a major amount of at least one base oil of lubricating viscosity and a minor amount of at least one lubricating oil additive for combination to formulate a lubricating oil composition; (b) providing a plurality of test reservoirs; (c) combining, under program control, the major amount of the base oil of lubricating viscosity and lubricating oil additive in varying percentage compositions to provide a plurality of different lubricating oil composition samples; and, (d) containing each of the different lubricating oil composition samples in the plurality of test reservoirs, as presently recited in Claim 1. Nor, as also acknowledged by the Examiner, does

Kolosov disclose or suggest a system for preparing a plurality of lubricant oil formulations, under program control, which comprises (a) a supply of at least one base oil of lubricating viscosity; (b) a supply of at least one lubricating oil additive; (c) a plurality of test reservoirs; (d) means for combining selected quantities of the at least one base oil of lubricating viscosity with selected quantities of the at least one lubricating oil additive to form a plurality of lubricating oil composition samples; and, (e) means for dispensing each lubricating oil composition sample in a respective test reservoir, as presently recited in Claim 23.

According to the Examiner, the Kolosov et al. reference discloses all of the limitations of the instant claims with the exception of a multiplicity of lubricating oil compositions having an additive therein in different percentages. Thus, it is the Examiner's apparent belief that one of ordinary skill in the art would have found it obvious to prepare a plurality of lubricant oil compositions containing different percentages of an additive therein in the plurality of test reservoirs taught by Kolosov et al., since Kolosov et al. teach that the flowable material to be screened in the combinatorial library can be a lubricant oil having an additive therein, and further that it is inherent that in a lubricant composition having an additive therein that the base lubricant oil is present in a major amount while the additive is present in a lesser minor amount.

However, inherency is not a substitute for some teaching or suggestion which supports the selection and use of the various elements in the particular claimed combination. *In re Newell*, 891 F.2d 899, 901, 13 USPQ2d 1248, 1250 (Fed. Cir. 1989). Kolosov et al. disclose a system and method for screening a library of a multitude of genera of material samples for rheological properties one of which may be a lubricant. However, a lubricant can be a grease, jelly, e.g., K-Y jelly, as well as powders, e.g., dry graphite, PTFE, etc., formulated with water

and can be used as is such that all lubricants may not even require an additive or, for that matter, be used in a lubricating oil composition. Kolosov et al. provides no teaching or suggestion that a lubricant can be a base oil of lubricating viscosity for use in a lubricating oil composition. Certainly, then, there is no appreciation in Kolosov et al. of a method and/or system for rapidly preparing a plurality of sample candidate lubricating oil compositions containing a major amount of at least one base oil of lubricating viscosity and a minor amount of at least one lubricating oil additive such that a high throughput preparation and subsequent screening of a vast number of diverse compositions can be achieved to identify leading lubricating oil compositions. Thus, nothing in Kolosov et al. would lead one skilled in the art to modify the system and method for testing the genera of flowable material disclosed therein and arrive at the presently recited method and system for preparing a plurality of different lubricant oil formulations which comprises, *inter alia*, (a) providing a major amount of at least one base oil of lubricating viscosity and a minor amount of at least one lubricating oil additive for combination to formulate a lubricating oil composition.


For the foregoing reasons, Claims 1-35 are believed to be nonobvious, and therefore patentable, over Kolosov et al. Accordingly, withdrawal of the rejection under 35 U.S.C. §103(a) is respectfully requested.

The Examiner has finally rejected Claims 36-37 under 35 U.S.C. §103(a) as being unpatentable over Kolosov et al. in view of Shtein et al., U.S. Publication No. 2005/0087131 ("Shtein et al.").

The foregoing deficiencies of Kolosov et al. discussed above with respect to the rejection of Claims 1-35 apply with equal force to this rejection. Shtein et al. does not cure and is not cited as curing the above-noted deficiencies of Kolosov et al. Rather, Shtein et al. is simply cited for the disclosure of depositing an organic material onto a substrate. Accordingly, Claims 36 and 37 are believed to be nonobvious, and therefore patentable, over Kolosov et al. and Shtein et al. and withdrawal of the rejection under 35 U.S.C. §103(a) is respectfully requested.

For the foregoing reasons, Claims 1-37 as presented herein are believed to be in condition for allowance. Such early and favorable action is earnestly solicited.

Respectfully submitted,



Michael E. Carmen
Reg. No. 43,533
Attorney for Applicants

M. CARMEN & ASSOCIATES, PLLC
170 Old Country Road – Suite 400
Mineola, NY 11501
Phone: (516) 992-1848
Facsimile: (516) 739-0981
MEC:bg